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| APPLICATION NO.   | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO.         | CONFIRMATION NO.       |
|---|-------------|----------------------|-----------------------------|------------------------|
| 10/706,568  | 11/12/2003  | Yoshitaka Nakayama   | 17210                       | 6919                   |
| 23389 7590 12/12/2007<br>SCULLY SCOTT MURPHY & PRESSER, PC<br>400 GARDEN CITY PLAZA<br>SUITE 300<br>GARDEN CITY, NY 11530 |             |                      | EXAMINER<br>MORAN, RANDAL D |                        |
|   |             |                      | ART UNIT<br>2135            | PAPER NUMBER           |
|   |             |                      | MAIL DATE<br>12/12/2007     | DELIVERY MODE<br>PAPER |

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

## Office Action Summary

Application No.

10/706,568

Applicant(s)

NAKAYAMA, YOSHITAKA

Examiner

Randal D. Moran

Art Unit

2135

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 24 September 2007.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-12 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-12 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- ☐ Notice of References Cited (PTO-892)
- ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- ☐ Information Disclosure Statement(s) (PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_
- ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_
- ☐ Notice of Informal Patent Application
- ☐ Other: \_\_\_\_\_

### **DETAILED ACTION**

1. Claims 1-12 are pending in the application.
2. This Office Action is in response to amendment filed 9/24/2007.
3. Below, Examiner has pointed out particular references contained in the prior art(s) of record in the body of this action for the convenience of the applicant. Although the specified citations are representative of the teachings in the art and are applied to the specific limitations within the individual claims, other passages and figures may apply as well. Applicant should consider the entire prior art as applicable as to the limitations of the claims. It is respectfully requested from the applicant, in preparing the response, to consider fully each reference in its entirety as potentially teaching all or part of the claimed invention, as well as the context of the passage as taught by the prior arts or disclosed by the examiner.

### ***Claim Rejections - 35 USC § 101***

1. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

2. **Claims 4 and 12** are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter, as it does not fall under any of the 4 statutory classes of inventions.

- Considering **Claims 4 and 12**, the claims are clearly not a "process" under § 101 because it is not a series of steps. A claimed signal has no physical structure, does not itself perform any useful, concrete and tangible result and, thus, does not fit within the definition of a "machine". A claimed signal is not matter, but a form of energy, and therefore is not a "composition of matter". Manufacture is defined as the production of articles for use from raw or prepared materials by giving to these materials new forms, qualities, properties, or combinations, whether by hand-labor or by machinery. A signal, a form of energy, does not fall within the accepted definition of manufacture. Thus, a signal does not fall within one of the four statutory classes of § 101 and is therefore deemed non-statutory subject matter.

See MPEP 2601.01.

### ***Claim Rejections - 35 USC § 102***

1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

2. **Claims 1-12** are rejected under 35 U.S.C. 102(b) as being anticipated by **Touboul (US 6,092,194)**, hereafter "Touboul".
3. Considering **Claims 1-4 and 10-12**, Touboul discloses a permission token management method (column 4- lines 14-28, Fig. 2, Fig. 3) comprising the steps of: storing tokens which correspond respectively to a plurality of permissions installed in a terminal (column 4- lines 14-40, Fig. 3) and are calculated by a predetermined conversion process performed to permission character strings indicating the permissions (column 4- lines 45-47, digital hash of the downloadable code); when a permission character string indicating a specific permission is input (column 4- lines 41-45), performing the predetermined conversion process to the permission character string (column 4- lines 41-45); and searching a token table using a token which is a conversion result of the conversion process (column 5- lines 24-29), and determining whether the token exists in the token table or not (column 5- lines 24-29, column 6- lines 4-12).
4. Considering **Claims 5 and 10-12**, Touboul discloses a permission token management method (column 4- lines 14-28, Fig. 2, Fig. 3) comprising the steps of: storing tokens which correspond respectively to a plurality of permissions

installed in a terminal (column 4- lines 14-40, Fig. 3) and are calculated by performing a predetermined conversion process to permission character strings indicating the permissions (column 4- lines 45-47, digital hash of the downloadable code); when a permission character string indicating a permission necessary for normally operating an application program intended to be downloaded is input (column 4- lines 41-45, column 6- lines 4-12), outputting a search request including the permission character string (column 4- lines 62-67, column 5- lines 1-16); performing the predetermined conversion process to the permission character string included in the search request (column 4- lines 45-47), and outputting a token which is a conversion result (column 4- lines 41-61); and by using the token (column 5- lines 4-16), determining whether a permission necessary for normally operating the application program is installed in the terminal or not (column 5- lines 24-29).

5. Considering **Claim 6**, Touboul discloses a token attribute information table (column 4- lines 14-28, Fig. 2, Fig. 3) within which, relating to each of the plurality of permissions installed in the terminal, a token of the permission and attribute information including conditions of use are registered in correspondence with each other (column 4- lines 14-28); a permission database (column 4- lines 21-28); token obtaining means for, when a permission character string indicating a permission desired for use is output from the application program at the time of executing the application program (column 4- lines 41-61), outputting a token

obtaining request including the permission character string to the conversion means (column 4- lines 41-61), and receiving a token output from the conversion means responding to the token obtaining request (column 5- lines 4-15); and second searching means for determining whether to authorize the application program to use the permission or not (column 6- lines 13-24), in accordance with the attribute information of the permission which corresponds to the token and is obtained by searching the permission database using the token received by the token obtaining means (column 4- lines 62-67, column 5- lines 1-15); wherein the conversion means has a function of, responding to the token obtaining request from the token obtaining means, performing the predetermined conversion process to the permission character string being requested for obtaining the token (column 4- lines 45-46), and outputting a conversion result to the token obtaining means (column 5- lines 4-15), and the search request/saving means has a function of, when the permission necessary for normally operating the application program is determined by the first searching means to be installed in the terminal (column 5- lines 24-29), obtaining the attribute information of the permission from the token attribute information table column 5- lines 36-38), and registering in the permission database the attribute information and the token of the permission in correspondence with each other (column 4- lines 14-28 and 57-61).

6. Considering **Claim 7**, Touboul discloses the conditions of use of the permission include an identifier of the application program (column 4- lines 41-45).
7. Considering **Claim 8**, Touboul discloses the conversion means has a function of obtaining a hash value corresponding to a permission character string (column 4- lines 45-47).
8. Considering **Claim 9**, Touboul discloses the token has less number of characters than that of the permission character string (column 4- lines 45-47, column 9- lines 43-56, Fig. 8).

### ***Response to Arguments***

1. Applicant's arguments filed 9/24/2007 have been fully considered but they are not persuasive. With respect to applicants arguments that Touboul fails to teach permissions. Examiner disagrees and directs the applicant to Touboul- column 4- lines 13-40, Fig. 3. Touboul figure 3 explicitly discloses Known Downloadables corresponding to various security policies.

Furthermore, in response to applicant's argument that the references fail to show certain features of applicant's invention, it is noted that the features upon which applicant relies (i.e., the bytecode of the application to be downloaded references the



permissions, or functions, using character strings such as...) are not recited in the rejected claim(s). Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993).

### ***Conclusion***

1. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the mailing date of this final action.

2. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Randal D. Moran whose telephone number is 571-270-1255. The examiner can normally be reached on M-F: 7:00 - 4:00.

Application/Control Number:  
10/706,568  
Art Unit: 2135

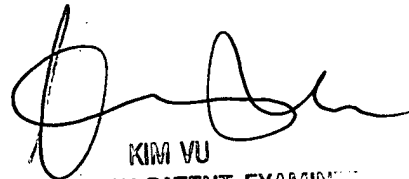
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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Kim Vu can be reached on 571-272-3859. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Randal D. Moran  
/RDM/

11/28/2007



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